REMARKS

Claims 14-21 remain pending in this application. Claims 14 and 17 were amended in this response, and new dependent claims 22-25 were added. No new matter has been introduced. Support for the amendments may be found, for example, on page 5,lines 24-34 of the original specification.

Claim 20 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14-19 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Gorsuch* (US Patent 6,151,332) in view of *Wang et al.* (US Patent 6,157,635). Applicants respectfully traverse the rejection. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination, fails to teach "a control unit for removing the filling data contained in the data stream with the constant data rate and for reformatting the useful data contained in the data stream into a format compatible with a data stream with a variable data rate via a packet-oriented connection by embedding the useful data into the transmission format of the packet-oriented connection, wherein said variable data rate corresponds to a variable transmission bandwidth available for the connection" as recited in claim 14, and similarly recited in claim 17.

Regarding *Gorsuch*, the reference teaches a technique for integrating services digital network (ISDN) and code division multiple access (CDMA) digital wireless communication protocols by a technique that strips off lower protocol layers, such as layers one and two of the ISDN protocol and sending only layer three and above messages over a more efficient wireless protocol (see Abstract, claim 1). This is done in order to avoid continuously supporting at least a 192kbps data rate throughout the duration of an end-to-end network connection, whether or not data actually needs to be transmitted (col. 5, lines 31-39). Under *Gorsuch*, the CDMA transceiver 140 "loops back" continuous synchronous data bits over the ISDN communication path to spoof the terminal equipment 110, 112 into believing that a sufficiently wide wireless communication path 160 is continuously available. However, only when there is actually data present on the terminal equipment to the wireless transceiver 140 does the side bandwidth be allocated. Accordingly, the network layer need not allocate the assigned wireless bandwidth over

the radio channels 160 for the entirety of the network layer communications session. In other words, when data is not being transmitted between the portable computer 110 and the remote node bandwidth management function 235 deallocates initially assigned radio channel bandwidth 160 and makes it available for another transceiver and another subscriber unit 101 (col. 5, lines 39-55).

Gorsuch further teaches that during operation, the reverse link 420 first accepts channel data from the ISDN modem 120 over the U interface and forwards it to the ISDN reverse spoofer 432, where echo bits are removed from data received and sent to the forward spoofer 432. The remaining layer three and higher level bits are used as useful data for transmission over a wireless link (col. 6, lines 32-40). During transmission, radio channels are partitioned into constant narrow bandwidths (e.g., 8kbps) and are subsequently multiplexed to a particular network layer connection, depending on the demand (col. 6, line 62 - col. 7, line 11).

It is thus clear that *Gorsuch* does not teach nor suggest "a data stream with a variable data rate" as each data stream (i.e., radio channel) in *Gorsuch* is set at a constant rate. Furthermore, the teaching in *Gorsuch* is clear that the end-to-end communications occur over an ISDN network, which the office action has conceded, is a "circuit-switched network having a constant rate transmission" (see page 2 of office action, paragraph 3). Thus, *Gorsuch* also cannot teach reformatting the useful data via a packet-oriented connection as required by the presently amended claims. Moreover, it is clear from the presently amended claims that *Gorsuch* also does not teach reformatting the useful data by embedding the useful data into the transmission format of the packet-oriented connection. *Wang* also fails to solve the deficiencies of *Gorsuch* in this regard as well.

The Office Action conceded that *Gorsuch* fails to teach the use of compressed video data, and relied on Wang as allegedly solving the deficiencies. Applicants submit this combination is wholly improper. For one, *Wang* relies on the transmission of H.320/H.221 data for video data (col. 9, lines 10-12), which is disclosed as having no bit stuffing (col. 9, lines 59-61). Therefore, it is not understood how the removal of echo bits in *Gorsuch* is even applicable to *Wang*. Secondly, the transmission of this data in *Wang* occurs on the sixth presentation layer in the OSI architecture for ISDN (col. 2, lines 37-41) - the disclosed configuration in *Gorsuch* is limited to the first three layers (FIG. 2, col. 4, line 42 - col. 5, line 14). It is inconceivable that the

configuration disclosed in *Gorsuch* could be adapted to transmit compressed video data using the first three protocol stacks of the OSI architecture.

In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would

be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Accordingly, Applicants submit that the rejection under 35 U.S.C. §103 is improper and should be withdrawn. An early Notice of Allowance is earnestly requested. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (112740-113) on the account statement.

Respectfully submitted,

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